

REMARKS/ARGUMENTS

Claims 1-10 are pending in the application. Claims 1-10 have been rejected. Claims 1-10 have been amended.

Specification.

The office action objected to the abstract for using legal phraseology. The amendment replaces the "said" with a "the" and replaced "an property" to "a property" in paragraph [0010].

Claim Objections.

Claims 1 and 6 have been amended to replace "an property" to "a property."

Rejections under 35 U.S.C. §101.

Claims 1-10 have been rejected as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. First, the Examiner's reliance on the non-technological arts exception to patentability was recently rejected in In re Lundgren, App. No. (Board of Patent Appeals 2005). There the Board stated: "our determination is that there is no judicially recognized separate 'technological art' test to determine patent eligible subject matter under §101 test." Lundgren, at page 7. Second, Applicants have amended claim 1 to include the language "computer implemented" as suggested by the examiner. Although such an amendment does not add much to the claim because the method claim can only be computer implemented. Consider for example the first step "instrumenting said at least partial run of said program to determine characterization information about each of said objects." This is something that expressly states that a program is run. A human being cannot run a program without a computer.

The examiner's reliance on AT&T Corp. v. Excel Communications Inc.¹ and In re Warmerdam² is misplaced. AT&T actually held that inventions such as Applicant's are patentable. In AT&T the Federal Circuit reversed the holding of a U.S. District Court that a patent ---- was invalid as relating to unpatentable subject matter. The AT&T patent at issue, entitled "Call Message Recording for Telephone Systems", issued on July 26, 1994. It describes a message record for long-distance telephone calls that is enhanced by adding a primary

1. 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

2. 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1999).

interexchange carrier ("PIC") indicator. The addition of the indicator aids long-distance carriers in providing differential billing treatment for subscribers, depending upon whether a subscriber calls someone with the same or a different long-distance carrier. In the instant case the claims are at least as non-abstract as in AT&T.

Likewise, in Warmerdam a claim at issue was:

"1. A method for generating a data structure which represents a shape of [sic] physical object in a position and/or motion control machine as a hierarchy of bubbles, comprising the steps of:

first locating the medial axis of the object and

then creating a hierarchy of bubbles on the medial axis."

Although the abstract call for a machine, in contrast with claim 1 in the instant case, the body of the Warmerdam claim does not recite any steps that could not be performed by a human being without the help of a machine.

In re Lowry, 32 F. 3d 1579, 32 USPQ2d 1031(Fed. Cir. 1994) (which was decided by the Federal Circuit Aug. 29, 1994) held that data structures *do* constitute patentable subject matter. In Lowry, the invention (assigned to Digital Equipment Corporation) had to do with attribute data objects (ADO's).³ Lowry's patent application -- "Data Processing System Having a Data Structure with a Single, Simple Primitive" -- related to the storage, use, and management of information residing in a memory. The PTO did not dispute the features and advantages of Lowry's claimed invention. The invention provides an efficient, flexible method of organizing stored data in a computer memory. The Federal Circuit held that the (PTO) must consider all claim limitations when determining patentability of an invention over the prior art, (citing In re Gulack), and that the PTO may not disregard claim limitations comprising printed matter. Thus, the court stated: "Lowry's ADOs do not represent merely underlying data in a database. ADOs contain both information used by application programs and information regarding their physical interrelationships within a memory. Lowry's claims dictate how application programs manage

³ According to the court, an ADO (or attribute data object) is a single primitive data element "comprising sequences of bits which are stored in the memory as electrical (or magnetic) signals that represent information." It contains information used by the application program and information regarding its relationship with other ADOs. A primitive is a fundamental instruction, statement, or operation.

information. Thus, Lowry's claims define functional characteristics of the memory.”

The Court further stated: “While the information content affects the exact sequence of bits stored in accordance with Lowry's data structures, the claims require specific electronic structural elements which impart a physical organization on the information stored in memory. Lowry's invention manages information. As Lowry notes, the data structures provide increased computing efficiency. If a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed.” *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q.2d 1031, (Fed. Cir. 1994). The instant case is much more like Lowry than Warmerdam. The examiner has not shown that the instant invention falls under one of the recognized exceptions to patentability: laws of nature, natural phenomena, and abstract ideas. See AT&T, at 1355. Therefore the rejection should be withdrawn.

Rejections under 35 U.S.C. §102.

The Office Action has rejected claims 1-10 under 35 U.S.C. §102(e) as being anticipated by a patent to Clawson et al (U.S. No. 6,112,304, hereafter "Clawson"). Applicant respectfully traverses the rejection for the following reasons.

Claim 1 relates to a method of performing the following a) instrumenting said at least partial run of said program to determine characterization information about each of said objects;

b) determining a desirable property for said objects;

c) determining a correlation between said desirable property and said characterization information for each of said objects;

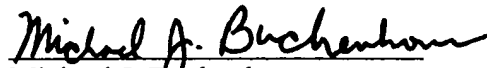
d) using said correlation to select an a property for an object subsequently created during an at least partial run of said program based upon characterization information about the subsequently created object. Clawson does not teach or suggest any of the foregoing.

Claims 2-5 are either directly or indirectly dependent on claim 1 and are patentable for at least

the same reasons that claim 1 is patentable. Claim 6 is an article of manufacture counterpart of claim 1 and hence is patentable for the foregoing reasons.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



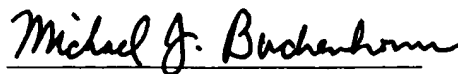
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I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein, are being deposited with the United States Postal Office on the date set forth below with sufficient postage as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.



Michael J. Buchenhorner

Date: December 21, 2005

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